

1624
PATENT
Customer Number 22,852
U.S. Patent Appln. No. 09/242,461
Attorney Docket No. 07164.0010

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Francis T. Boyle et al.

Serial No.: 09/242,461

Filed: February 17, 1999

For: 3-MERCAPTOPYRROLIDINES
AS FARNESYL PROTEIN
TRANSFERASE INHIBITORS



Group Art Unit: 1624

Examiner: B. Coleman

#7
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Assistant Commissioner for Patents
Washington, DC 20231

Sir:

RESPONSE TO RESTRICTION REQUIREMENT

Applicants submit this response to the Office Action dated September 25, 2000.

Applicants also submit a petition for a two-month extension of time and the associated fee. The Examiner has required restriction under 35 U.S.C. § 121 between:

Group I, claims 1-6 and 8-13, drawn to compounds, compositions and the method of use of formulae III, IV, V, and compounds compositions, method of use and process of preparing the compounds of formula I where L is non-heterocyclic containing;

Group II, claims 1, 7 and 9-13 drawn to compounds, compositions, the method of use and process of preparing the compounds of formula I where L is piperazine containing and the compounds of formula A where n=0; and;

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Group III, claims 1, 7 and 9-13, drawn to compounds, compositions, the method of use and process of preparing the compounds of formula I where L is diazepine containing and the compounds of formula A where $n=1$.

Applicants elect Group II with traverse. Applicants believe there would be no undue burden on the Examiner to consider all of the claims. For instance, the Examiner has not shown it would be an undue burden to combine Groups II (where L is piperazine and $n=0$) and III (where L is diazepine & $n=1$). Applicants further reserve the right to rejoin or pursue non-elected subject matter in one or more divisional applications.

First of all, the restriction between Groups II and III indicates a distinction between compounds of "formula A where $n=0$ " and compounds of "formula A where $n=1$ ". The variable "n," however, is defined in the definition of R; not in the definition of A. Therefore, the restriction does not make sense and requires clarification.

Secondly, Applicants traverse the restriction between Groups II and III because piperazine and homopiperazines are closely structurally related compounds. Applicants submit that the search and examination of such structurally similar compounds will not cause a significant burden on the Examiner.

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Please grant any extensions of time required to enter this response and charge
any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: December 26, 2000

By: Charles E Van Horn
Charles E. Van Horn
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